

DOCKET No. IZ-200308-001 (SAMS04-08001)
U.S. SERIAL No. 10/693,089
PATENT

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1, 3, 4, 8, 9, 10, 15, 16, and 17 have been amended.

Reconsideration of Claims 1-20, as amended, is respectfully requested.

Amendments to Specification

Portions of the Specification have been amended to correct the reference numeral for the "foot" element to read "foot 56" instead of "foot 54." The element "foot 56" is correctly labeled in the drawings. Therefore, no new matter has been added by the amendments. The amended text of the Specification is now correctly correlates "foot 56" with the drawings.

Claim Rejections under 35 U.S.C. § 102(b)

The final Office Action mailed April 5, 2005, rejected Claims 1-14 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 2,990,213 to Kolacinski ("Kolacinski").

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed

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invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

In order to more particularly claim the Applicant's invention, the Applicant has amended certain of the pending claims. The Applicant directs the Examiner's attention to amended Claim 1, which contains the unique and non-obvious limitations emphasized below:

1. (Currently Amended) A tool for lifting a pad, comprising:
a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having a sloped upper surface for slidably receiving a portion of the pad;
a first member pivotally coupled to the non-pivoted jaw structure; and
a second member pivotally coupled to the first member, the second member having a surface opposite to the sloped surface of the lower jaw portion and operable for clamping the portion of the pad against the sloped surface when the first member is pivoted upwards. (Emphasis added)

The Applicant respectfully submits that the *Kolacinski* reference does not disclose, suggest, or even hint at the above-emphasized limitations of amended Claims 1-14.

It is clear that the upper jaw portion 30 and the lower jaw portion 32 of the Applicant's invention form a unitary one-piece jaw structure 18 that is not pivoted. The upper jaw portion 30 and lower jaw portion 32 are not pivoted with respect to each other. A first member (handle 16) is pivotally coupled to the non-pivoted jaw structure 18. A second member (foot 56) is pivotally coupled to the first member (handle 16).

The Applicant respectfully submits that Claims 1-14, as amended, are not anticipated by the *Kolacinski* reference. The final Office Action of April 5, 2005 asserted that the reference numerals 20 and 21 of the *Kolacinski* structure referred to a jaw, with reference numeral 21

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indicating an upper jaw portion and reference numeral 20 indicating a lower jaw portion. The drawings of the *Kolacinski* reference show "a holder or pliers generally designated 2 comprising a pair of lever members 3 and 4." (*Kolacinski*, Col. 1, Lines 51-53). "The members 4 and 3 respectively provide jaws 20 and 21." (*Kolacinski*, Col. 1, Lines 64-65). Thus, the *Kolacinski* reference discloses a holder or pliers with a pair of pivotally connected jaws 20 and 21.

In contrast, amended Claim 1 recites a non-pivoted jaw structure having an upper jaw portion 30 and a lower jaw portion 32. Claims 1-7, as amended, therefore claim a structure that is not anticipated by the *Kolacinski* device because the upper jaw portion 30 and the lower jaw portion 32 of the Applicant's device are not pivoted.

The final Office Action of April 5, 2005 further asserted that in the *Kolacinski* reference either reference numeral 12 or reference numeral 13 indicates a first member pivotally coupled to the jaw. Reference numeral 12 refers to the handle portion of lever member 3, at the opposite end of jaw element 21. Handle portion of lever member 3 is a unitary part of jaw element 21. Handle portion of lever member 3 is not pivotally connected to jaw element 21. If the pilot pin 10 were removed, handle portion of lever member 3 would still be a unitary part of jaw element 21.

Similarly, reference numeral 13 refers to the handle portion of lever member 4, at the opposite end of jaw element 20. Handle portion of lever member 4 is a unitary part of jaw element 20. Handle portion of lever member 4 is not pivotally connected to jaw element 20. If the pilot pin 10 were removed, handle portion of lever member 4 would still be a unitary part of jaw element 20. (*Kolacinski*, Figure 1, Col. 1, Line 60).

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For these reasons the *Kolacinski* reference teaches a lever member with a jaw element at one end and a handle portion at the other end. This is not the same as the Applicant's first member (handle 16) pivotally coupled to a non-pivotal jaw structure 18, as recited in amended Claim 1.

In addition, the *Kolacinski* reference does not show a "second member pivotally coupled to the second member," as claimed in amended Claim 1. The final Office Action of April 5, 2005 asserted that the *Kolacinski* reference showed "a member 32, 33 pivotally coupled to the first member." (April 5, 2005 Office Action, Page 4, Line 1). However, the member 32, 33 in *Kolacinski* is not coupled to a first member. That is, the member 32, 33 is not coupled to the handle portion of lever member 3, or to the handle portion of lever member 4. Instead, the member 32, 33 is coupled to jaw element 21. The final Office Action of April 5, 2005 identifies jaw element 21 as corresponding to the Applicant's upper jaw portion 30. Therefore, the member 32, 33 (supposedly corresponding to the second member of amended Claim 1) is not pivotally coupled to the first member, as claimed in amended Claim 1.

Therefore, independent Claim 1, as amended, contains unique and non-obvious limitations that are not disclosed, suggested, or even hinted at in the *Kolacinski* reference. This being the case, Claim 1 is patentable over the *Kolacinski* reference. Dependent Claims 2-7 depend from independent Claim 1 and contain all of the unique and non-obvious limitations recited in Claim 1. Thus, Claims 2-7 also are patentable over the *Kolacinski* reference. For these reasons, the Applicant respectfully requests that the rejection of Claims 1-7 under 35 U.S.C. § 102 be withdrawn and that Claims 1-7, as amended, be passed to allowance.

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The Applicant also directs the Examiner's attention to amended Claim 8, which contains the unique and non-obvious limitations emphasized below:

8. (Currently Amended) A chemical mechanical polishing pad removal tool, comprising:

a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the upper jaw portion having an arcuate lower surface for contacting portions of an upper surface of the chemical mechanical polishing pad, the lower jaw portion having a sloped upper surface spaced below and opposite to the arcuate lower surface for slidably receiving a portion of the pad;

a first member pivotally coupled to the non-pivoted jaw structure; and

a second member pivotally coupled to the first member, the second member having a surface projecting below the arcuate lower surface of the upper jaw portion and being opposite to the sloped surface of the lower jaw portion, the second surface being operable for clamping the portion of the pad against the sloped surface when the first member is pivoted upwards. (Emphasis added)

The Applicant respectfully submits that the *Kolacinski* reference does not disclose, suggest, or even hint at the above-emphasized limitations of amended Claims 8-14.

It is clear that the upper jaw portion 30 and the lower jaw portion 32 of the Applicant's invention form a unitary one-piece jaw structure 18 that is not pivoted. The upper jaw portion 30 and lower jaw portion 32 are not pivoted with respect to each other. A first member (handle 16) is pivotally coupled to the non-pivoted jaw structure 18. A second member (foot 56) is pivotally coupled to the first member (handle 16).

The Applicant respectfully submits that Claims 8-14, as amended, are not anticipated by the *Kolacinski* reference. The final Office Action of April 5, 2005 asserted that the reference numerals 20 and 21 of the *Kolacinski* structure referred to a jaw, with reference numeral 21 indicating an upper jaw portion and reference numeral 20 indicating a lower jaw portion.

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The drawings of the *Kolacinski* reference show "a holder or pliers generally designated 2 comprising a pair of lever members 3 and 4." (*Kolacinski*, Col. 1, Lines 51-53). "The members 4 and 3 respectively provide jaws 20 and 21." (*Kolacinski*, Col. 1, Lines 64-65). Thus, the *Kolacinski* reference discloses a holder or pliers with a pair of pivotally connected jaws 20 and 21.

In contrast, amended Claim 1 recites a non-pivoted jaw structure having an upper jaw portion 30 and a lower jaw portion 32. Claims 1-7, as amended, therefore claim a structure that is not anticipated by the *Kolacinski* device because the upper jaw portion 30 and the lower jaw portion 32 of the Applicant's device are not pivoted.

The final Office Action of April 5, 2005 further asserted that in the *Kolacinski* reference either reference numeral 12 or reference numeral 13 indicates a first member pivotally coupled to the jaw. Reference numeral 12 refers to the handle portion of lever member 3, at the opposite end of jaw element 21. Handle portion of lever member 3 is a unitary part of jaw element 21. Handle portion of lever member 3 is not pivotally connected to jaw element 21. If the pilot pin 10 were removed, handle portion of lever member 3 would still be a unitary part of jaw element 21.

Similarly, reference numeral 13 refers to the handle portion of lever member 4, at the opposite end of jaw element 20. Handle portion of lever member 4 is a unitary part of jaw element 20. Handle portion of lever member 4 is not pivotally connected to jaw element 20. If the pilot pin 10 were removed, handle portion of lever member 4 would still be a unitary part of jaw element 20. (*Kolacinski*, Figure 1, Col. 1, Line 60).

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For these reasons the *Kolacinski* reference teaches a lever member with a jaw element at one end and a handle portion at the other end. This is not the same as the Applicant's first member (handle 16) pivotally coupled to a non-pivotal jaw structure 18, as recited in amended Claim 8.

In addition, the *Kolacinski* reference does not show a "second member pivotally coupled to the second member," as claimed in amended Claim 8. The final Office Action of April 5, 2005 asserted that the *Kolacinski* reference showed "a member 32, 33 pivotally coupled to the first member." (April 5, 2005 Office Action, Page 4, Line 1). However, the member 32, 33 in *Kolacinski* is not coupled to a first member. That is, the member 32, 33 is not coupled to the handle portion of lever member 3, or to the handle portion of lever member 4. Instead, the member 32, 33 is coupled to jaw element 21. The final Office Action of April 5, 2005 identifies jaw element 21 as corresponding to the Applicant's upper jaw portion 30. Therefore, the member 32, 33 (supposedly corresponding to the second member of amended Claim 8) is not pivotally coupled to the first member, as claimed in amended Claim 8.

Therefore, independent Claim 8, as amended, contains unique and non-obvious limitations that are not disclosed, suggested, or even hinted at in the *Kolacinski* reference. This being the case, Claim 8 is patentable over the *Kolacinski* reference. Dependent Claims 9-14 depend from independent Claim 8 and contain all of the unique and non-obvious limitations recited in Claim 8. Thus, Claims 9-14 also are patentable over the *Kolacinski* reference. For these reasons, the Applicant respectfully requests that the rejection of Claims 9-14 under 35 U.S.C. § 102 be withdrawn and that Claims 9-15, as amended, be passed to allowance.

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Claim Rejections Under 35 U.S.C. § 103 (a)

The final Office Action of April 5, 2005 rejected Claims 15-20 under 35 U.S.C. § 103(a) as being unpatentable over *Kolacinski* in view of United States Patent No. 6,086, 126 to Krauss ("Krauss").

In order to more particularly claim the Applicant's invention, the Applicant has amended certain of the pending claims. The Applicant directs the Examiner's attention to amended Claim 15, which contains the unique and non-obvious limitations emphasized below:

15. (Original) A chemical mechanical polishing pad removal tool; comprising:

a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the upper jaw portion having an arcuate lower surface for contacting portions of an upper surface of the chemical mechanical polishing pad, the lower jaw portion having a sloped upper surface spaced below and opposite to the arcuate lower surface for slidably receiving a portion of the pad, the sloped upper surface terminating at a lower end in a rounded end;

a handle pivotally coupled to the non-pivoted jaw structure; and

a member pivotally coupled to the handle, the member having a textured surface projecting below the arcuate lower surface of the upper jaw portion and being opposite to the sloped surface of the lower jaw portion, the textured surface being operable for clamping the portion of the pad against the sloped surface when the handle is pivoted upwards. (Emphasis added)

The Applicant hereby incorporates by reference all of the arguments previously made in connection with the claim rejections made under 35 U.S.C. § 102. The Applicant respectfully submits that, for the same reasons described with regard to amended Claim 1 and with regard to amended Claim 8, the *Kolacinski* reference does not disclose, suggest, or even hint at the above emphasized limitations of amended Claim 15. The *Krauss* reference does nothing to overcome this shortcoming. The *Krauss* reference simply describes a clamping element that wedges against a flat

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component 38. As shown in Figure 4 of Krauss the flat component 38 must be able to fit within the gripping slot 20 before the clamping element 26 can work. Unlike the pad 12 in the present invention the flat component 38 is not affixed to an underlying structure (like platen 14).

Therefore amended Claim 15 presents patentable subject matter over the *Kolacinski* reference, the *Krauss* reference, or the combination of the *Kolacinski* and *Krauss* references. For these reasons, the Applicant respectfully requests that the rejection of Claims 15-20 under 35 U.S.C. § 103 be withdrawn and that Claims 15-20, as amended, be passed to allowance.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

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SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at wmunck@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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